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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
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In re Application of :  
Cory et al :  
Serial No.: 09/508,832 : Decision on Petition  
Filing Date: 10 July 2000 :  
Attorney Docket No. 017227/0159 :  
:

This letter is in response to the Petition filed 12 February 2003, requesting reconsideration of the decision on applicants' petition under 37 CFR 1.144, mailed 12 December 2002. The delay in acting upon this petition is regretted.

#### **BACKGROUND**

The prosecution history for this application filed under 35 USC 371 has been reviewed in the previous petition decision and will not be repeated here.

On 12 April 2003, Applicants filed an amendment to cancel claims 1-5, 10-14, 23-27, 31-35, 37-61 and to amend claims 6-9, 15-22, 28 and 29. Claims 6-9, 15-22, 28-30, 36 are all pending and, as amended, are directed either to the elected invention, nucleic acid SEQ ID No. 9, encoding SEQ ID No. 10 (claims 6-9, 21-22, 28) or to the non-elected invention, protein having SEQ ID No. 10 (claims 15-20, 29-30 and 36).

#### **DISCUSSION**

The file record, Restriction Requirement, first petition and its decision, and the second petition have been considered carefully.

In Part (A), the petition requests withdrawal of the restriction requirement between Group X, polynucleotides encoding SEQ ID No. 10 and Group V, polypeptides of SEQ ID No. 10. Applicants correctly point out that the polynucleotide claims, as presently amended, are considered free of the prior art by the examiner. Applicants go on to argue that Groups V and X are therefore linked by a special technical feature. A review of these claims show that they do not conform to the format of claims accepted unity the PCT Administrative Instructions, Unity of Inventions, Example 17.

PCT Rule 13.2 requires (1) that the groups be linked by a same or corresponding technical feature and (2) that the technical feature defines a contribution over the prior art.

DNA and protein are made up of different subunits (nucleic versus amino acids) and perform different functions (transcription and replication versus a protein's activity) and thus do not share the "same technical feature". Example 17 of the PCT Administrative Instructions sets forth one situation in which DNA and protein claims may share a corresponding technical feature. Example 17 allows for unity between protein molecule X and DNA that encodes protein X. In Example 17, the claimed subject matter is linked by a one-to-one correspondence, in view of the fact that the protein is encoded by the DNA and the DNA encodes the protein. Example 17 allows for multiple DNA sequences to be claimed with one protein sequence, in order to compensate for the degenerative nature of the DNA codon usage, whereby that one protein may be encoded by multiple DNA sequences.

Turning now to the claims in this application, the protein claim is broader than one protein species: a wide variety of protein molecules are claimed by the limitations of "sequence having at least about 45% identity to SEQ ID No. 10" (see Claim 15, for example). The DNA which encodes one of those protein molecules would not encode the others. Similarly the instant DNA molecules are also claimed broadly. The nucleic acid molecules of Group V's Claim 7, for example, is not required to encode a protein having SEQ ID No. 10. Thus the protein and DNA inventions do not share a corresponding technical feature and unity is lacking. The fact that the polynucleotide claims are considered free of the prior art does not alter this position. PCT Rule 13.2 requires, first, that the claims share a technical feature.

The Petition argues that the Commissioner's 1996 pronouncement accommodates a reasonable number of sequences. The Official Gazette Notice set forth situations in which multiple polynucleotides may be examined together. The Official Gazette Notice is silent concerning the concurrent examination of DNA and protein.

In Part (B), the petition requests that Groups I-IV, polynucleotides encoding SEQ ID Nos. 2, 4, 6 and 8 be examined together with the elected invention, Group V, polynucleotides encoding SEQ ID No. 10. This request is moot since no claims are pending that recite the non-elected inventions Groups I-IV. Applicants are requesting rejoinder of inventions that have been canceled from the application.

## **DECISION**

The petition is **DENIED** for the reasons set forth above.

The application is being sent back to the examiner for consideration of the amendment and response filed 21 April 2003 and completion of an Office action of the elected invention, claims 6-9, 21-22 and 28.

Any request for reconsideration of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter, please contact Special Program Examiner Julie Burke by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria VA 22313-1450 or by telephone at (703) 308-7553 or by facsimile transmission at (703) 305-7230.

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